

REMARKS

Rejections Under Judicially Created Doctrine of Obviousness-Type Double-Patenting

The Examiner has maintained the rejection of claims 2-3, 5-6, and 11 under the judicially created doctrine of obviousness-type double-patenting over claims 1-4 of commonly owned U.S. Patent No. 6,426,342 (“the ‘342 patent”) in view of U.S. Patent No. 5,889,007 (“Pfister”), over claims 1-2 and 5-6 of commonly owned U.S. Patent No. 6,610,681 (“the ‘681 patent”) in view of Pfister, and over claims 1, 3, 6-7, 9-10, 14-15, 18, 27-28, 30 and 33-38 of commonly owned U.S. Patent No. 6,627,625 (“the ‘625 patent”) in view of Pfister. The Examiner reiterates the same reasons set forth in the previous Office Action mailed May 21, 2008.

Applicant strongly disagrees with the Examiner’s aforementioned rejections. Simply, the Examiner continues to confuse the difference between a definition of a term and an example of a term. Moreover, the Examiner’s reliance on *Toro* and *Renishaw* as a basis for equating an example with a definition is clearly misplaced. *See, e.g.*, Examiner Remarks, page 4; *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295 (Fed. Cir. 1999); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998). Neither *Toro* nor *Renishaw* stand for the premise that illustrative examples found in the specification may serve as alternative definitions of a generic term for the purposes of navigating the law of non-statutory double patenting. Ironically, neither *Toro* nor *Renishaw* even consider issues of double patenting, and instead are generally concerned with issues of claim construction (*Toro*, 199 F.3d at 1299 (“[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.”); *Renishaw*, 158 F.3d at 1250 (“Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings”)). Therefore, *Toro* and *Renishaw* stand for the premise that the specification is properly consulted to determine the boundaries of the claim.

In issues of double patenting, Applicant agrees that as part of the enquiry in determining whether an application claim is merely an obvious variation of an invention claimed in a patent, it is permissible to use the patent disclosure to “learn the meaning of terms and in ‘interpreting the coverage of [a] claim.’” *In re Basell Poliolefine Italia SPA*, 547 F.3d 1371, 1378 (Fed. Cir. 2008) (quoting *In re Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970) (emphasis added)). For example, to the extent that the Examiner does not know what is meant by the terms “beta lactam compound” or “beta lactamase inhibitor” as used in the reference patent, the specification of that patent may be considered to understand the meets and bounds of the term, and also to determine whether the patentee has applied other than the plain and ordinary meaning to that term. In the instant case, it is clear that the patentee has not applied a special meaning to the term. Beta lactamase inhibitors are simply those compounds that inhibit beta lactamase. Clavulanic acid, recited in the claims of the instant invention, is of course a beta lactamase inhibitor, and accordingly falls within the scope of the term.

Nevertheless, those illustrative embodiments of beta lactamase inhibitors found in the patentee's disclosure do not define the boundaries of that term unless it is clear from the disclosure that the term should be so limited. Thus, the Examiner's attempt to reduce either of the terms "beta lactam compound" or "beta lactamase inhibitor" to be limited to clavulanic acid is completely without foundation. *See, e.g., In re Vogel*, 422 F.2d 438, 442 (C.C.P.A. 1970) ("A claim is a group of words defining only the boundary of the patent monopoly.... The disclosure, however, sets forth at least one tangible embodiment within the claim...").

Despite this woefully improper rejection, Applicant transmits herewith a terminal disclaimer under 37 C.F.R. § 1.321(b) disclaiming any term beyond the expiration date of the three commonly owned patents cited by the Examiner (U.S. Patent Nos. 6,426,342, 6,610,681, and 6,627,625), all of which have the same expiration date. Accordingly, Applicant believes that the rejections for alleged obviousness-type double-patenting is overcome, and requests withdrawal of those rejections.

CONCLUSION

Applicant believes that the foregoing remarks are fully responsive to the Examiner's Official Action mailed February 9, 2009, and that the claims of the instant application are now in condition for allowance leading to issuance. Such action is respectfully requested.

Respectfully submitted,

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